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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,490	02/09/2007	Rodrigo Fuscelli Pytel	033794/313056	7294
826	7590	03/03/2010	EXAMINER	
ALSTON & BIRD LLP			BLAKELY III, NELSON CLARENCE	
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101 SOUTH TRYON STREET, SUITE 4000			ART UNIT	PAPER NUMBER
CHARLOTTE, NC 28280-4000			1614	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/596,490	FUSCELLI PYTEL ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	NELSON C. BLAKELY III	1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 August 2009.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 11,12 and 22-30 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10,13-21,31 and 32 is/are rejected.
- 7) Claim(s) 8 and 9 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 August 2009 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ .  | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Application Status***

Claims 1-32 of the instant application are pending. Claims 11, 12 and 22-30 are withdrawn, and claims 31 and 32 are added, pursuant to Applicant's Amendment, filed 08/07/2009. Accordingly, instant claims 1-10, 13-21, 31 and 32 are presented for examination on their merits.

Applicant's Arguments, filed 08/07/2009, have been fully considered.

Rejections/objections not reiterated from previous Office Actions are hereby **withdrawn**. The following rejections/objections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

### ***Applicant's Amendment***

Applicant's Amendment, filed 08/07/2009, wherein the specification and claims 2-10 and 13-21 are amended, claims 11, 12 and 22-30 are withdrawn, and claims 31 and 32 are added, is acknowledged.

### ***Drawings***

The drawings were received on 08/07/2009. These drawings are acceptable.

### ***Claim Objections***

Claims 8 and 9 are objected to for the following informality:

With regard to instant claims 8 and 9, Applicant is encouraged to insert the term “the” or “said” before the second recitation of the term “composition” in line 2. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9, 13-16 and 19-21\* were previously rejected under 35 U.S.C. 103(a) as being unpatentable over Guskey *et al.* (U.S. Patent No. 5,976,514), in view of Brandt *et al.* (U.S. Patent No. 6,696,067B2), as evidenced by Filipski *et al.* (U.S. Patent Publication No. 2003/0124083A1). \*The instant rejection further encompasses instant claims 31 and 32 pursuant to Applicant's Amendment, filed 08/07/2009.

**Applicant's Arguments**

Applicant alleges there is absolutely no teaching in Guskey *et al.* that would guide one of ordinary skill in the art to select the specific 5 silicone compositions that are recited in claim 1 to create the claimed composition. Further, Applicant alleges that by the lengthy excerpt, recited on pages 12-15 of the Remarks, filed 08/07/2009, it can be seen that Guskey *et al.* embraces a significantly broad and lengthy laundry list of possible ingredients for use as the mitigating material in the reference composition. Applicant alleges that because the Examiner acknowledges that the list of possible silicone components is non-limiting, as recited by Guskey *et al.*, it is even less likely that

one of skill in the art would select the 5 silicone compositions recited in independent claim 1.

Applicant alleges Guskey *et al.* specifically teaches that the reference system is anhydrous, and thus does not include water as a carrier (instant claim 32).

Examiner's Response

Applicant's Arguments, filed 08/07/2009, have been fully considered but they are not persuasive. It is acknowledged that the cosmetic art is saturated with silicone oils, including the claimed cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone. It is further acknowledged, in column 9, line 3, through column 11, line 30, wherein Guskey *et al.* disclose a list of suitable silicone-containing mitigating materials that may be present in an amount of from about 1% to about 60% by weight of the reference topical composition. One of ordinary skill in the art, at the time of the invention, would have been motivated to combine cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone in a single combination composition. MPEP § 2144.06 is directed to art-recognized equivalence for the same purpose. Alternatively, it allows the skilled artisan to combine equivalents that are known to treat the same purpose. It is *prima facie* obvious to use in combination two or more ingredients that have previously been used separately for the same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Obviousness does not require absolute predictability, but only the reasonable expectation of success. Specific statements in the reference that would spell out the

claimed invention are not necessary to show obviousness since questions of obviousness involve not only what the reference expressly teach, but also what they would collectively suggest to one of ordinary skill in the art, at the time of the invention.

*In re Burckel* (CCPA) 201 USPQ 67.

Further, the specific combination of features instantly claimed is disclosed within the broad teachings of the reference. However, such “picking and choosing” within several variables does not necessarily give rise to anticipation. *Corning Glass Works v. Sumitomo Elec.*, 868 F.2d 1251, 1262 (Fed. Circ. 1989). Whereas the reference does not provide any motivation to select this specific combination of variables, cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone, anticipation cannot be found.

Accordingly, it must be remembered that “[w]hen a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious”. *KSR v. Teleflex*, 127 S. Ct. 1727, 1740 (2007)(quoting *Sakraida v. A.G. Pro*, 425 U.S. 273, 282 (1976)). “[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious”, the relevant question is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” (*Id.*). Addressing the issue of obviousness, the Supreme Court noted that the analysis under 35 USC 103 “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art

would employ.” *KSR v. Teleflex*, 127 S.Ct. 1727, 1741 (2007). The Court emphasized that “[a] person of ordinary skill is... a person of ordinary creativity, not an automaton.” *Id.* at 1742.

Consistent with this reasoning, it would have obvious to have selected various combinations of various disclosed ingredients [e.g., cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone] from within a prior art disclosure, to arrive at compositions “yielding no more than one would expect from such an arrangement”.

With regard to instant claims 31 and 32, as mentioned *supra*, Guskey *et al.* disclose wherein the mitigating material is present in an amount from about 1% to about 60% by weight of the composition, which encompasses the instantly claimed amount between 3% and 5% by weight of the composition (instant claim 31). Further, in column 1, lines 27-31, Guskey *et al.* disclose antiperspirant and deodorant products containing volatile silicone fluids which may be aqueous or anhydrous. Additionally, in Examples 26 and 27, in column 19, Guskey *et al.* disclose antiperspirant emulsions, both aqueous and anhydrous, respectively. Therefore, a skilled artisan, at the time of the invention, would have contemplated an aqueous topical cosmetic composition wherein water is a carrier (instant claim 32).

Accordingly, the instant invention, as claimed in claims 1-9, 13-16, 19-21, 31 and 32, is *prima facie* obvious over the combination of the aforementioned teachings.

Claims 10, 17 and 18 was previously rejected under 35 U.S.C. 103(a) as being unpatentable over Guskey *et al.* (U.S. Patent No. 5,976,514), in view of Brandt *et al.* (U.S. Patent No. 6,696,067B2), as evidenced by Filipski *et al.* (U.S. Patent Publication No. 2003/0124083A1), as applied to claims 1-9, 13-16 and 19-21 above, and further in view of Fourman *et al.* (U.S. Patent No. 4,963,591) and Breton *et al.* (U.S. Patent 6,267,971B1).

Applicant's Arguments

See Applicant's Arguments *supra*. Additionally, Applicant alleges that the combination of references fails to disclose or suggest a composition that includes a filmogenic system containing cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone, as recited in independent claim 1, and therefore, claim 1 and any claims dependent thereon are patentable over the prior art.

Examiner's Response

Applicant's Arguments, filed 08/07/2009, have been fully considered but they are not persuasive. It is acknowledged wherein Applicant has not addressed the instant rejection separately. However, the aforementioned Examiner's Response applies to the crux, e.g., a filmogenic system having cyclopentasiloxane, dimethiconol, dimethicone (polydimethylsiloxane), trimethylsiloxysilicate and stearyl dimethicone, of Applicant's Arguments to the instant rejection.

Accordingly, the instant invention, as claimed in claims 10, 17 and 18, is *prima facie* obvious over the combination of the aforementioned teachings.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NELSON C. BLAKELY III whose telephone number is (571) 270-3290. The examiner can normally be reached on Mon - Thurs, 7:00 am - 5:30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. B. III/  
Examiner, Art Unit 1614

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614